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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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P. Thomas Watson

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10/12/2006

WITHERS & KEYS FOR BELL SOUTH

P. O. BOX 71355

MARIETTA, GA 30007-1355

EXAMINER

HAMZA, FARUK

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/029,173

Applicant(s)

WATSON ET AL.

Examiner

Faruk Hamza

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8, 23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 9-22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8, 23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. This action is responsive to the RCE filed on March 20, 2006. Applicant's election without traverse of Claims 6-8,23 and 25-30 in the reply filed on June 26, 2006 is acknowledged. Claims 6-7 and 25 have been amended. Claims 6-8,23 and 25-30 are pending.

***Claim Objections***

2. Claim 28 objected to because of the following informalities: Claim dependency is improper, it is dependent of claim 29. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 6,25,27 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Yun (U.S. Patent Number 6,915,531) hereinafter referred as Yun.

Yun teaches the invention as claimed including an open cable set top box diagnosing system in which a point of deployment, separated from a main circuit unit (See abstract).

As to claim 6, Yun teaches a method for communicating with a remote set top box (STB) comprising the step of:

receiving at a location remote from the STB a first item of information related to parameter settings associated with the STB from the STB (Column 2, lines 34-46; Column 9, lines 44-Column 10, lines 44, Yun discloses server receiving system state information associated with STB, parameter settings claim language is broad. System state information is broadly interpreted to be parameter settings associated to STB); and

comparing at the first location remote from the STB the first item of information with a second item of information, the second item of information being related to parameter settings expected to be associated with the STB

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(Column 5, lines 31-57; Column 9, lines 44-Column 10, lines 44, Yun discloses comparing received information from STB with expected information); and

based on a result of the comparing, communicating an instruction involving the parameter settings from the first location remote from the STB to the STB (Column 5, lines 31-57; Column 9, lines 44-Column 10, lines 44, Yun discloses communicating instruction based on comparing result).

As to claim 25, Yun teaches A computer readable medium having encoded instructions that causes at least one computer to:

receive a first item of information from a set top box (STB), wherein the first item of information relates to resources associated with the STB (Column 2, lines 34-46; Column 9, lines 44-Column 10, lines 44, Yun discloses server receiving system state information associated with STB, parameter settings claim language is broad. System state information is broadly interpreted to be parameter settings associated to STB);

retrieve a second item of information from a database spaced from the STB, wherein the second item of information relates to an expected configuration of the STB (Column 5, lines 31-57; Column 9, lines 44-Column 10, lines 44, Yun discloses determining if there are any error or improper operation in STB);

compare the first item of information with the second item of information; and send an STB instruction to the STB wherein the instruction is adapted to perform a function on the STB that is related to the resources (Column 5, lines

31-57; Column 9, lines 44-Column 10, lines 44, Yun discloses comparing received information from STB with expected information).

As to claim 27, Yun teaches The computer readable medium according to claim 25, wherein the encoded instructions further cause the STB instructions to be sent to a remote resource manager of the STB and wherein the encoded instructions further cause the remote resource manager to detect the resources and send the first item of information (Column 5, lines 31-57; Column 9, lines 44-Column 10, lines 44).

As to claim 30, Yun teaches the computer readable medium of claim 25, wherein the STB instructions provide for at least one of enabling a resource of the STB related to the first item of information, disabling a resource of the STB related to the first item of information, including authorization keys related to the first item of information, and causing the STB to diagnose a problem of the STB related to the first item of information (Column 5, lines 31-57; Column 9, lines 44-Column 10, lines 44).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yun as applied above, and further in view of Nobakht et al. (U.S. Patent Number 7,111,051) hereinafter referred as Nobakht.

Yun teaches the invention substantially as claimed including an open cable set top box diagnosing system in which a point of deployment, separated from a main circuit unit (See abstract).

As to claim 7, Yun teaches the method according to claim 6,

Yun does not explicitly teach the claim limitation of receiving information remote from the STB from a database.

However, Nobakht teaches the claim limitation of receiving information remote from the STB from a database (Fig. 1, Column 7, lines 1-20).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify Yun by adding functionality for receiving information remote from the STB from a database, which will allow the system to store videos. One would be motivated to do such to enhance system's usability.

Claim 26 does not define or teach any new limitation other than above claim 7. Therefore, rejected for similar reasons.

5. Claims 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yun as applied above, and further in view of Moroney (U.S. Patent Number 6,532,593) hereinafter referred as Moroney.

Yun teaches the invention substantially as claimed including an open cable set top box diagnosing system in which a point of deployment, separated from a main circuit unit (See abstract).

As to claim 8, Yun teaches the method according to claim 6

Yun does not explicitly teach the claim limitation of fixed disc drive of STB.

However, Moroney teaches the claim limitation of fixed disc drive of STB.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify Yun by adding hard disc of STB, which will allow the system to store videos. One would be motivated to do such to enhance system's usability.

As to claim 28, Yun teaches the computer readable medium of claim 25.

Yun does not explicitly teach claim limitation of determining resource capacity of STB.

However, Moroney teaches claim limitation of determining resource capacity of STB (Column 5, lines 34-56).



It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify Yun by adding functionality for determining resource capacity of STB, which will allow the users to know system's capability. One would be motivated to do such to enhance system's usability.

6. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yun as applied above, and further in view of Official Notice.

Yun teaches the invention substantially as claimed including an open cable set top box diagnosing system in which a point of deployment, separated from a main circuit unit (See abstract).

As to claim 23, Yun teaches the method of claim 6.

Yun does not explicitly teach claim limitation of STB is integrated into a television.

However, "Official Notice" is taken that the concept and advantages of STB integrated into television including predefined time schedule is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yun by adding STB integrated into television, which will make the system compact. One would be motivated to do so to enhance the system's usability.

Claim 29 does not define or teach any new limitation other than above claim 23. Therefore, rejected for similar reasons.

7. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

### ***Response to Arguments***

8. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll -free).

Faruk Hamza

Patent Examiner

Group Art Unite 2155

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER